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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,909	03/10/2004	David Baran	GBTV 1001-1	1626
23470	7590	07/10/2009		
HAYNES BEFFEL & WOLFELD LLP			EXAMINER	
P O BOX 366			STANLEY, MARK P	
HALF MOON BAY, CA 94019				
			ART UNIT	PAPER NUMBER
			2427	
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			07/10/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/796,909

**Applicant(s)**

BARAN ET AL.

**Examiner**

MARK P. STANLEY

**Art Unit**

2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 April 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5-7 and 9-11 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,2,5-7 and 9-11 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to the amendment filed on 4/10/2009
2. Claims 1-2, 5-7 and 9-11 are pending in the application.

### ***Response to Arguments***

3. Applicant's arguments filed 4/10/2009 have been fully considered but they are not persuasive.

Applicant argues that Logan discloses viewers ability to cheat the program supplier of reimbursement revenues via manually access to metadata. However the Examiner respectfully disagrees, paragraph 423 of Logan explicitly states that 'the paid subscriber would have access to metadata' and that 'the non-paid subscriber would not have access to these marks'. Thus, where the same metadata (marks) used for automated removal and manual removal would only be available to the paid subscriber that is reimbursing the provider for content removal and the non-paid subscriber would not have the ability to cheat the reimbursing to the provider for content removal as they would not be provided with the metadata (marks) for doing so, as it is clear in the disclosure of Logan that commercial removal is only to be allowed by those reimbursing the content providers regardless of how ethical the viewers are or are not. Furthermore, if the user acted 'honestly' and did not cheat -- would it not anticipate the claimed limitation? Anticipation need only require that the claim limitations be met for at least one scenario described by the embodiment.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 5-7, and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Logan et al. (US 2003/0093790).

**Regarding claim 1**, Logan discloses “a process for allowing a viewer at a TV display to bypass undesired segments of a TV program, including:” (abstract, Figs. 1-2)

“a. storing one or more TV programs containing a first class of metadata including a start location and a stop location of potentially undesired segments;” ([0055]-[0056], [0302], [0310], [0331], [0421])

“b. retrieving one of the TV programs for display;” ([0301], Fig. 2, item 211)

“c. defining, with a second class of metadata, unwanted segments specific to the user of said TV display,”

d. matching the first class of metadata with the second class of metadata;

e. removing, responsive to matching the first class of metadata with the second class of metadata, undesired segments from the TV program; and” ([0055]-[0056], [0423], automatic removal of commercials based on metadata)

"f. reimbursing program suppliers for a financial loss occasioned by removed material" ([0423], a 'paid' subscriber pays provider for automatic removal of commercials)

**Regarding claim 2**, Logan discloses "the process as set forth in claim 1, further including time shifting two or more programs to fill time space resulting from removing the undesired segments from the TV program" ([0137], [0244]).

**Regarding claim 5**, Logan discloses "an apparatus for removing unwanted TV material comprising" (abstract, Figs. 1-2)

"a shared personal video recorder (PVR) network server at a distribution system head end, said PVR network server for storing multiple TV programs with one or more TV programs containing TV metadata;" ([0299], [0435], NPVR, Figs. 1-2)

"a specific program delivered to a specific TV display, with the specific program having stored metadata defining unwanted program segments;" ([0301]-[0302], [0310], [0331], [0421])

"a processor and logic coupled to the shared personal video recorder network server adapted to compare the TV metadata with the stored metadata and to remove undesired program segments from the specific program; and" ([0055]-[0056], [0423])

further logic adapted to cause reimbursement of a program supplier for financial loss from removal of the undesired program segments from the specific program" ([0423], a 'paid' subscriber pays provider for automatic removal of commercials).

**Regarding claim 6**, Logan discloses “the apparatus as set forth in claim 5, wherein the logic to remove undesired program segments is further adapted to time shift two or more programs to fill time space resulting from removing undesired segments from the TV program” ([0137], [0244]).

**Regarding claim 7**, Logan discloses “the apparatus as set forth in claim 5 further including logic adapted to record and report viewer decisions to automatically remove undesired program segments” ([0295], [0421], viewer history).

**Regarding claim 9**, Logan discloses “an apparatus for removing unwanted TV material comprising:” (abstract, Figs. 1-2)

“personal video recorder (PVR) server that stores multiple TV programs with one or more such programs containing TV metadata;” ([0299], [0435], Figs. 1-2)

“a specific program delivered to a specific TV display, with the specific program having stored metadata defining unwanted program segments; and” ([0301]-[0302], [0310], [0331], [0421])

“a processor and logic coupled to the shared personal video recorder network server adapted to compare the TV metadata with the stored metadata and to remove undesired program segments from the specific program; and” ([0055]-[0056], [0423])

further logic adapted to cause reimbursement of a program supplier for financial loss from removal of the undesired program segments from the specific program.” ([0423], a ‘paid’ subscriber pays provider for automatic removal of commercials).

**Regarding claim 10**, Logan discloses “the apparatus as set forth in claim 9, wherein the logic to remove undesired program segments is further adapted to time shift two or more programs to fill time space resulting from removing undesired segments from the TV program” ([0137], [0244]).

**Regarding claim 11**, Logan discloses “the apparatus as set forth in claim 9 further including logic Adapted to record and report viewer decisions to automatically remove undesired program segments” ([0295], [0421], viewer history).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contacts***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK P. STANLEY whose telephone number is (571)270-3757. The examiner can normally be reached on 8:00AM - 5:00PM Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark P Stanley/



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Examiner, Art Unit 2427

/Scott Beliveau/

Supervisory Patent Examiner, Art Unit 2427